

REMARKS

The amendments are the same amendments that were proposed in both previous Replies After Final Rejection. These amendments were refused entry in the Advisory Action for lack of support in the original disclosure and new matter regarding the amendments to claim 10. Applicants urge reconsideration.

Claim 10 was amended to recite that the homogeneous pigment composition comprises: $\geq 40\%$ 50% by weight of one or more effect pigments. The change from $\geq 40\%$ to $\geq 50\%$ merely incorporated the terms of previous claim 26 into claim 10. This is clearly supported by the disclosure at page 5, lines 27-29, of the original disclosure, and there is no dispute as to this.

Claim 10 was further amended to recite:

- 0.5 - ~~59.5%~~ 49.5% by weight of a styrene-modified polyacrylate having an acid number > 90 mg KOH/g, and
- 0.5 - ~~50%~~ 49.5% by weight of water.

These changes are not literally supported by the disclosure but are inherently supported due to the inherent requirement that the %'s of the components add up to 100%. Thus, inherently, since the minimum amount of the effect pigment is now 50%, the amount of the remaining components cannot be more than 50%. As a result the maximum amount of the polyacrylate cannot possibly be as high as 59.5%. The maximum amount, however, can inherently be calculated based on the minimum amounts of all the other components. These minimum requirements are: 50% of the pigment, 0.5% of the water and 0% each of the neutralizing agent and modifying agent. This equals 50.5% of the other components, at a minimum, which limits the maximum amount of the polyacrylate to 49.5%. Analogously, the maximum

amount of the water cannot be 50% but is limited to 49.5% based on the minimum requirements of the other components.

The Examiner's statement in the Advisory Action that there are many ways to reduce the amount of the other components to allow for the increased amount of effect pigment is correct. The ranges of claim 10 above allow for this. But the increase in the amount of the pigment does inherently restrict some of the possibilities for the other components, i.e., the maximum amount of any component is restricted by the minimum amount requirements of the other components. This is why the maximum amounts of the polyacrylate and water components have to be reduced in the claims and why the amendment to do so is inherently supported in the disclosure.

As applicants previously pointed out, the subject matter of a claim need not be described in the specification literally in order for the specification to satisfy the description requirement of 35 U.S.C. §112, first paragraph. Claim recitations may be inherently supported by the disclosure, as it would be understood by those in the art. Such is the case for the amendments to claim 10 above.

Although the mathematical requirements discussed above should provide sufficient inherency on their own, an additional independent basis for support of the amendment is found in the case law, e.g., In re Voss, 194 USPQ 267, 272 (footnote 14) (CCPA 1977). Therein it was found that a broader recited range necessarily described a more narrow range fully within the broader range.

For the above reasons, it is urged that the proposed amendments are supported by the disclosure and do not introduce new matter. Further, the amendments should be entered because they direct the claims to the allowable subject matter indicated in the Final Office Action. Thus, the substance of previous claim 26 – indicated to be allowable – is

incorporated into claim 10. Claim 19 is written in independent form and claims 20-23 are amended to depend from claim 19. The amendments to claims 19-23 do not change the scope of these claims. The Advisory Action notes that claim 19 was not amended as to the amounts of components as in claim 10. But this was not necessary for claim 19 because this claim was found independently allowable due to the dry material recitation.

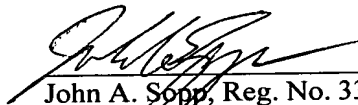
It is submitted that the above amendments would put the application in condition for allowance since they direct the claims to the indicated allowable subject matter. The rejections under 35 U.S.C. §112 and 35 U.S.C. §103 are rendered moot by the amendments. The amendments do not raise new issues or present new matter and do not present additional claims. The amendments were made to direct the claims to the subject matter indicated in the Final Office Action to be allowable. Thus, they were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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